

**M.P.E.P. § 509.03**

behalf of the United States any subject invention . . .” See 35 U.S.C. 202(c)(4). The Federal agencies do not qualify as nonprofit organizations for paying reduced patent fees under the rules. Applying this construction to the licensing of an invention to a Federal agency by a person, small business concern, or nonprofit organization pursuant to a funding agreement under 35 U.S.C. 202(c)(4) would preclude their qualifying for paying reduced fees. This, however, would frustrate the intent of Public Law 97-247 and Public Law 96-517 when taken together.

Government organizations as such, whether domestic or foreign, cannot qualify as nonprofit organizations as defined in 37 CFR 1.27(a)(3). Thus, for example, a government research facility or other government-owned corporation could not qualify. 37 CFR 1.27(a)(3) was based upon 35 U.S.C. 201(i), as established by Public Law 96-517. The limitation to “an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a))” would by its nature exclude the U.S. government and its agencies and facilities, including research facilities and government corporations. State and foreign governments and governmental agencies and facilities would be similarly excluded. 37 CFR 1.27(a)(3) is not intended to include within the definition of a nonprofit organization government organizations of any kind located in any country. A university or other institution of higher education located in any country would qualify, however, as a “nonprofit organization” under 37 CFR 1.27(a)(3) even though it has some government affiliation since such institutions are specifically included.

A wholly owned subsidiary of a nonprofit organization or of a university is considered a part of the nonprofit organization or university and is not precluded from qualifying for small entity status.

### 509.03 Claiming Small Entity Status [R-3]

*37 CFR 1.27. Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity*

*status and notification of loss of entitlement to small entity status are required; fraud on the Office.*

\*\*\*\*\*

\*\*>

(b) *Establishment of small entity status permits payment of reduced fees.*

(1) A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h)(1).

(2) Submission of an original utility application in compliance with the Office electronic filing system by an applicant who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section in that application allows the payment of a reduced filing fee pursuant to 35 U.S.C. 41(h)(3).<

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

- (i) Be clearly identifiable;
- (ii) Be signed (see paragraph (c)(2) of this section); and
- (iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign and file the written assertion.* The written assertion can be signed by:

- (i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;
- (ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or
- (iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

\*\*>

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), 1.16(b), 1.16(c), 1.16(d), 1.16(e), or the small entity basic national fee set forth in § 1.492(a), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(f), or § 1.16(g).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.<

(4) *Assertion required in related, continuing, and reissue applications.* Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(e) *Only one assertion required.*

(1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is

made in accordance with the requirements of this section, but note paragraph (h) of this section.

(g)(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

(2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(h) *Fraud attempted or practiced on the Office.*

(1) Any attempt to fraudulently establish status as a small entity, or pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

#### 37 CFR 1.4. Nature of correspondence and signature requirements.

\*\*\*\*\*

\*\*>

(d)(4) *Certifications.* (i) Section 10.18 certifications: The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) of this chapter may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15) of this chapter.

(ii) *Certifications as to the signature:* (A) Of another: A person submitting a document signed by another under paragraphs (d)(2) or (d)(3) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature.

(B) *Self certification:* The person inserting a signature under paragraphs (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

(C) *Sanctions:* Violations of the certifications as to the signature of another or a person's own signature, set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under § 10.18(c) and (d) of this chapter.<

\*\*\*\*\*

37 CFR 10.18. *Signature and certificate for correspondence filed in the Patent and Trademark Office.*

\*\*\*\*\*

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

\*\*\*\*\*

In order to establish small entity status for the purpose of paying small entity fees, any party (person, small business concern or nonprofit organization) must make an assertion of entitlement to small entity status in the manner set forth in 37 CFR 1.27(c)(1) or (c)(3), in the application or patent in which such small entity fees are to be paid. Under 37 CFR 1.27, as long as all of the rights remain in small entities, the fees established for a small entity can be paid. This includes circumstances where the rights were divided between a person, a small business concern, and a nonprofit organization, or any combination thereof.

Under 37 CFR 1.4(d)(\*>4<), an assertion of entitlement to small entity status, including the mere payment of an exact small entity basic filing fee, inherently contains a certification under 37 CFR 10.18(b). It is not required that an assertion of entitlement to small entity status be filed with each fee paid. Rather, once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due. 37 CFR 1.27(g)(1). Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. 37 CFR 1.27(g)(2).

Status as a small entity may be established in a provisional application by complying with 37 CFR 1.27.

Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The filing of an application under 37 CFR 1.53 as a continuation-in-part, continuation or division (including a continued prosecution application under 37 CFR 1.53(d)), or the filing of a reissue application requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application. Submission of a request for continued examination (RCE) under 37 CFR 1.114 does not require a new determination or assertion of entitlement to small entity status since it is not a new application.

Examiners may use the following form paragraph to notify applicant that he or she may qualify for small entity status.

#### ¶ 5.05 *Small Entity Status*

This application may qualify for "Small Entity Status" and, therefore, applicant may be entitled to the payment of reduced fees. In order to establish small entity status for the purpose of paying small entity fees, applicant must make a determination of entitlement to small entity status under 37 CFR 1.27(f) and make an assertion of entitlement to small entity status in the manner set forth in 37 CFR 1.27(c)(1) or 37 CFR 1.27(c)(3). Accordingly, if applicant meets the requirements of 37 CFR 1.27(a), applicant

must submit a written assertion of entitlement to small entity status under 37 CFR 1.27(c) before fees can be paid in the small entity amount. See 37 CFR 1.27(d). The assertion must be signed, clearly identifiable, and convey the concept of entitlement to small entity status. See 37 CFR 1.27(c)(1). No particular form is required.

### **I. ASSERTION BY WRITING**

Small entity status may be established by the submission of a simple written assertion of entitlement to small entity status. The assertion must be signed, clearly identifiable, and convey the concept of entitlement to small entity status. 37 CFR 1.27(c)(1). The written assertion is not required to be presented in any particular form. Written assertions of small entity status or references to small entity fees will be liberally interpreted to represent the required assertion. The written assertion can be made in any paper filed in or with the application and need be no more than a simple sentence or a box checked on an application transmittal letter.

Practitioners may continue to use former USPTO forms or similar forms if they believe such small entity forms serve an educational purpose for their clients.

### **II. PARTIES WHO CAN ASSERT AND SIGN AN ENTITLEMENT TO SMALL ENTITY STATUS BY WRITING**

The parties who can assert entitlement to small entity status by writing include all parties permitted by 37 CFR 1.33(b) to file a paper in an application, including a registered practitioner. 37 CFR 1.27(c)(2)(i). Additionally, one of the individuals identified as an inventor, or a partial assignee, can also sign the written assertion. 37 CFR 1.27(c)(2)(ii) and (iii). By way of example, in the case of three *pro se* inventors for a particular application, one of the three inventors upon filing the application can submit a written assertion of entitlement to small entity status and thereby establish small entity status for the application, (but see paragraph VI. below). Where rights are divided between a person, small business concern, and nonprofit organization, or any combination thereof, only one party is required to assert small entity status. For example, where one of two inventors has assigned his or her rights in the invention, it is sufficient if either of the two inventors or the assignee asserts entitlement to small entity status.

Any inventor is permitted to submit a written assertion of small entity status, including individuals identified as inventors but who are not officially named of record as an executed oath or declaration under 37 CFR 1.63 has not yet been submitted. See 37 CFR 1.41(a)(1). Where an application is filed without an executed oath or declaration pursuant to 37 CFR 1.53(f), the Office will accept the written assertion of an individual who has merely been identified as an inventor on filing of the application (e.g., application transmittal letter) as opposed to having to be named as an inventor by the filing of an executed oath or declaration under 37 CFR 1.63 (37 CFR 1.41(a)(1)). 37 CFR 1.4(d)(\*) and 37 CFR 10.18(b) are seen as sufficient basis to permit any individual to provide a written assertion so long as the individual identifies himself or herself as an inventor. An actual inventor who has not been identified as an inventor (e.g., by way of application transmittal letter) or named as an inventor (i.e., executed 37 CFR 1.63 oath or declaration) in the file record may not file a written assertion as to small entity entitlement.

Where an oath or declaration under 37 CFR 1.63 is later filed, any original written assertion as to small entity status (which has been previously appropriately submitted to the Office) will remain unless changed by an appropriate party under 37 CFR 1.27(g)(2). Where a later-filed oath or declaration under 37 CFR 1.63 sets forth an inventive entity that does not include the person who initially was identified as an inventor and who asserted small entity status, small entity status will also remain.

An assignee asserting small entity status is not required to submit a 37 CFR 3.73(b) certification whether the assignee is a partial assignee or an assignee of the entire right, title, and interest, (but see paragraph III. below).

### **III. PARTIES WHO CAN FILE THE WRITTEN ASSERTION ONCE SIGNED**

A distinction exists as to who can file a written assertion of entitlement to small entity status once the written assertion is signed. 37 CFR 1.27(c)(2)(ii) and 37 CFR 1.33(b) permit one of several inventors to file as well as to sign a written assertion. The same is not true for a partial assignee. 37 CFR 1.27(c)(2)(iii). While a partial assignee may sign a written assertion,

the written assertion must be filed by an appropriate party under 37 CFR 1.33(b).

#### IV. ASSERTION BY PAYMENT OF SMALL ENTITY BASIC FILING OR BASIC NATIONAL FEE

The payment of an exact small entity basic filing (37 CFR 1.16(a), (\*>b<), (\*>c<), (\*>d<), or (\*>e<)) or basic national fee (37 CFR 1.492(a)\*\*) is also considered to be a sufficient assertion of entitlement to small entity status. 37 CFR 1.27(c)(3). An applicant filing a patent application and paying an exact small entity basic filing or basic national fee automatically establishes small entity status for the application even without any other assertion of small entity status. This is so even if an applicant inadvertently selects the wrong type of small entity basic filing or basic national fee for the application being filed (e.g., the exact small entity basic filing fee for a design application is selected but the application is a utility application). If small entity status was not established when the basic filing or basic national fee was paid, such as by payment of a \*>non-small< entity basic filing or basic national fee, a later claim to small entity status requires a written assertion under 37 CFR 1.27(c)(1). Payment of a small entity fee other than a small entity basic filing or basic national fee (e.g., extension of time fee, or issue fee) without inclusion of a written assertion is not sufficient.

Even though applicants can assert small entity status only by payment of an exact small entity basic filing or basic national fee, the Office encourages applicants to also file a written assertion of small entity status as well as to pay the exact amount of the small entity basic filing or basic national fee. The Office's application transmittal forms include a check box that can be used to submit a written assertion of small entity status. A written assertion will provide small entity status should applicant fail to pay the exact small entity basic filing or basic national fee. The provision providing for small entity status by payment of an exact small entity basic filing or basic national fee is intended to act as a safety net to avoid possible financial loss to inventors or small businesses that qualify for small entity status.

Even though small entity status is accorded where the wrong type of small entity basic filing fee or basic

national fee is selected but the exact amount of the fee is paid, applicant still needs to pay the correct small entity amount for the basic filing or basic national fee where selection of the wrong type of fee results in a deficiency. While an accompanying general authorization to charge any additional fees suffices to pay the balance due of the proper small entity basic filing or basic national fee, specific authorizations to charge fees under 37 CFR 1.17 or extension of time fees do not suffice to pay any balance due of the proper small entity basic filing or basic national fee because they do not actually authorize payment of small entity amounts. If payment is attempted of the proper type of basic filing or basic national fee (applicant correctly identifies the type of fee for the type of application being filed), but the amount of the fee paid is not the exact small entity fee required (an incorrect fee amount is supplied) and a written assertion of small entity status is not present, small entity status will not be accorded. The Office will mail a notice of insufficient basic filing or basic national fee with a surcharge due if an authorization to charge the basic filing or basic national fee is not present. The Office does not consider a basic filing or basic national fee submitted in an amount above the correct fee amount, but below the non-small entity fee amount, as a request to establish small entity status unless an additional written assertion is also present. The submission of a basic filing or basic national fee below the correct fee amount also does not serve to establish small entity status.

Where an application is originally filed by a party, who is in fact a small entity, with an authorization to charge fees (including basic filing or national fees) and there is no indication (assertion) of entitlement to small entity status present, that authorization is not sufficient to establish small entity status unless the authorization is specifically directed to small entity basic filing or basic national fees. The general authorization to charge fees will continue to be acted upon immediately and the full (not small entity) basic filing or basic national fees will be charged. Applicant will have three months under 37 CFR 1.28 to request a refund by asserting entitlement to small entity status. This is so even if the application is a continuing application where small entity status had been established in the prior application.

## V. PARTIES WHO CAN ASSERT AND FILE SMALL ENTITY STATUS BY PAYMENT

Where small entity status is sought by way of payment of the basic filing or basic national fee, any party (including a third party), may submit payment, such as by check, and small entity status will be accorded.

## VI. CONTINUED OBLIGATIONS FOR THOROUGH INVESTIGATION OF SMALL ENTITY STATUS

While small entity status is not difficult to obtain, it should be clearly understood that applicants need to do a complete and thorough investigation of all facts and circumstances before making a determination of actual entitlement to small entity status. 37 CFR 1.27(f). Where entitlement to small entity status is uncertain, it should not be claimed.

The assertion of small entity status (even by mere payment of the exact small entity basic filing fee) is not appropriate until such an investigation has been completed. For example, where there are three *pro se* inventors, before one of the inventors pays the small entity basic filing or basic national fee to establish small entity status, the single inventor asserting entitlement to small entity status should check with the other two inventors to determine whether small entity status is appropriate.

If small entity status is desired on the basis that the entity is a small business concern, the investigation should include a review of whether the business is a small business concern as defined by section 3 of the Small Business Act (Public Law 85-536 as amended by Public Law 106-50). Review of whether the business concern meets the >size< standards set forth in 13 CFR \*\*>121.801 through 121.805< to be eligible for reduced patent fees is also appropriate. Additionally, if the business has assigned, granted, conveyed or licensed (or is under an obligation to do so) any rights in the invention to others directly or indirectly, the same review for each other entity would also be appropriate.

Furthermore, once status as a small entity has been established in an application, a new determination of entitlement to small entity status is needed (1) when the issue fee is due and (2) when any maintenance fee is due. It should be appreciated that the costs incurred in appropriately conducting the initial and subsequent investigations may outweigh the benefit of claiming

small entity status. For some applicants it may be desirable to file as a \*>non-small< entity (by not filing a written assertion of small entity status and by submitting \*>non-small< entity fees) rather than undertaking the appropriate investigations which may be both difficult and time-consuming and which may be cost effective only where several applications are involved.

The intent of 37 CFR 1.27 is that the person making the assertion of entitlement to small entity status is the person in a position to know the facts about whether or not status as a small entity can be properly established. That person, thus, has a duty to investigate the circumstances surrounding entitlement to small entity status to the fullest extent. It is important to note that small entity status must not be claimed unless the person or persons can unequivocally make the required self-certification.

The U.S. Patent and Trademark Office does not give advisory opinions as to whether or not a specific individual or organization qualifies as a small entity. In establishing reduced fees for persons, small business concerns, and nonprofit organizations, the Congressional consideration of the legislation which became Public Law 97-247 indicated an intent that the U.S. Patent and Trademark Office rely exclusively on a self-certification that a patent applicant qualifies as an independent inventor (now person), small business concern, or nonprofit organization. In addition, it was also stated during Congressional consideration of the legislation that no additional resources would be required to administer the system whereby fees would be reduced for small entities.

In view of the intent expressed during Congressional consideration of the legislation, it would be inappropriate for the U.S. Patent and Trademark Office to give advisory opinions as to entitlement to small entity status. Accordingly, any individual seeking to establish status as a small entity for purposes of paying the fee in an application or patent must file the assertion required by 37 CFR 1.27 and in so doing is self-certifying entitlement to small entity status.

Consistent with 37 CFR 1.4(d)(\*>4<), the payment of a small entity basic filing or national fee constitutes a certification under 37 CFR 10.18(b). Thus, a simple payment of the small entity basic filing or basic national fee, without a specific written assertion, activates the provisions of 37 CFR 1.4(d)(\*>4<) and, by

that, invokes the self-certification requirement set forth in 37 CFR 10.18(b), regardless of whether the party is a practitioner or non-practitioner.

## VII. REMOVAL OF STATUS

Once small entity status is established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due. 37 CFR 1.27(g)(1). 37 CFR 1.27(g)(2) requires that notification of any change in status resulting in loss of entitlement to small entity status be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. 37 CFR 1.27(g)(2) also requires that the notification of loss of entitlement to small entity status be in the form of a specific written assertion to that extent, rather than only payment of a *>non-small<* entity fee. For example, when paying the issue fee in an application that has previously been accorded small entity status and the required new determination of continued entitlement to small entity status reveals that status has been lost, applicant should not just simply pay the *>non-small entity<* issue fee or cross out the recitation of small entity status on Part B of the Notice of Allowance and Fee(s) Due (PTOL-85), but should *>(A) check the appropriate box on Part B of the PTOL-85 form to indicate that there has been a change in entity status and applicant is no longer claiming small entity status, and (B) pay the fee amount for a non-small entity.<*

For correcting errors in small entity status, see paragraph X below.

## VIII. IMPROPERLY ESTABLISHING SMALL ENTITY STATUS

37 CFR 1.27(h) indicates that any attempt to fraudulently establish status as a small entity or pay fees as a small entity will be considered as a fraud practiced or attempted on the Office. Applicants should not rely on any oral advice inadvertently given by an Office employee as to entitlement to small entity status. In addition, improperly and with intent to deceive establishing status as a small entity or paying fees as a small entity will be considered as a fraud practiced or

attempted on the Office. Normally, the Office will not question a claim to status as a small entity.

## IX. REFUNDS BASED ON LATER ESTABLISHMENT OF SMALL ENTITY STATUS

*37 CFR 1.28. Refunds when small entity status is later established; how errors in small entity status are excused.*

(a) *Refunds based on later establishment of small entity status.* A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.

(b) *Date of payment.*

(1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid;

(2) The date when a deficiency payment is paid in full determines the amount of deficiency that is due, pursuant to paragraph (c) of this section.

\*\*\*\*\*

37 CFR 1.28(a) provides a three-month time period for requesting a refund of a portion of a *>non-small<* entity fee based on later establishment of small entity status. The start date of the three-month refund period of 37 CFR 1.28(a) is the date the full fee has been paid. See 37 CFR 1.28(b)(1). Payment by authorization to charge a deposit account is treated for refund purposes the same as payments by other means (e.g., check or credit card authorizations), with each being treated as paid (for refund purposes) on the date of receipt in the Office as defined by 37 CFR 1.6. Thus, the date of receipt of an authorization to charge fees starts the three-month period for refunds under 37 CFR 1.28(a), not the date of debit of the fee to a deposit account. If a payment is mailed with a Certificate of Mailing under 37 CFR 1.8, the three month period for requesting a refund will start on the actual date of receipt of the payment in the Office, and not the Certificate of Mailing date. If a payment is filed by Express Mail under 37 CFR 1.10, the date of deposit with the United States Postal Service (shown by the "date-in" on the Express Mail mailing label or other official USPS notation) is the date of receipt of the payment by the Office under 37 CFR 1.10(a) and the three month period for requesting a refund starts

on the date shown by the "date-in" on the Express Mail mailing label rather than the date when the payment actually reaches the Office.

Request for refunds, along with the assertions under 37 CFR 1.27(c), should be addressed to Mail Stop 16, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

## X. CORRECTING ERRORS IN SMALL ENTITY STATUS

*37 CFR 1.28. Refunds when small entity status is later established; how errors in small entity status are excused.*

\*\*\*\*\*

(c) *How errors in small entity status are excused.* If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

(1) *Separate submission required for each application or patent.* Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (e.g., checks) and itemizations are required for each application or patent. See § 1.4(b).

(2) *Payment of deficiency owed.* The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.

(i) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error;

(ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:

(A) Each particular type of fee that was erroneously paid as a small entity, (e.g., basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;

(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between

two one-month extension of time fees erroneously paid as a small entity but on different dates;

(C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

(3) *Failure to comply with requirements.* If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month non-extendable time period under § 1.136(a) to avoid the return of the fee deficiency paper, at the option of the Office.

(d) *Payment of deficiency operates as notification of loss of status.* Any deficiency payment (based on a previous erroneous payment of a small entity fee) submitted under paragraph (c) of this section will be treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

\*\*\*\*\*

37 CFR 1.28(c) provides that if small entity status is established in good faith and the small entity fees are paid in good faith, and it is later discovered that such status as a small entity was established in error or through error the Office was not notified of a change of status, the error will be excused upon compliance with the separate submission and itemization requirements of 37 CFR 1.28(c)(1) and (c)(2), and the deficiency payment requirement of 37 CFR 1.28(c)(2). The deficiency amount owed under 37 CFR 1.28(c) is calculated using the date on which the deficiency was paid in full. See 37 CFR 1.28(b)(2).

37 CFR 1.28(c)(1) requires that a deficiency paper be limited to one application or patent file. Where, for example, the same set of facts has caused errors in payment in more than one application and/or patent file, a separate paper must be submitted in each file for which an error is to be excused.

37 CFR 1.28(c)(2) requires that for each fee that was erroneously paid as a small entity, the deficiencies owed must be paid, and the payment of the deficiencies must be itemized. The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. Where there has been a fee decrease, the deficiency owed is equal to the amount (previously) paid in error, not the difference between

the amount (previously) paid in error and the new lower **>non-small<** entity fee. 37 CFR 1.28(c)(2)(ii) requires the following itemizations: (A) the particular fee involved (e.g., basic filing fee, extension of time fee); (B) the small entity fee amount actually paid and when (for example, distinguishing between two one-month extension of time fees erroneously paid on two different dates); (C) the actual deficiency owed for each fee previously paid in error; and (D) the total deficiency owed (i.e., the sum of the individual deficiencies owed).

Under 37 CFR 1.28(c)(3), the failure to comply with the requirements of 37 CFR 1.28(c)(1) and (c)(2) permits the Office at its option to either charge a processing fee (37 CFR 1.17(i)) to process the paper or require compliance within a one-month non-extendable time period to avoid return of the paper.

Any paper submitted under 37 CFR 1.28(c) is treated as a notification of loss of small entity status under 37 CFR 1.27(g)(2). See 37 CFR 1.28(d).

A maintenance fee improperly paid as a small entity where small entity status has been established but is no longer appropriate will be treated as a matter under 37 CFR 1.28(c) and will not be considered to involve expiration of the patent under 37 CFR 1.378. On the other hand, payment of a maintenance fee in the small entity amount where small entity status has not been established would result in the expiration of the patent under 37 CFR 1.378 unless the full maintenance fee due or a written assertion of small entity status is timely filed.

## **510 U.S. Patent and Trademark Office Business Hours [R-3]**

The U.S. Patent and Trademark Office **>(USPTO or Office)<** working hours are 8:30 a.m. to 5:00 p.m., Monday through Friday, excluding Federal holidays in the District of Columbia. Outside these hours, only **>USPTO<** employees are authorized to be in areas of the **>USPTO<** other than the Public Search Rooms.

The hours for the **>Public Search Facility** in Alexandria are 8:00 a.m. to 8:00 p.m., and the hours for the Trademark **>Paper Facility** in Arlington are 8:00 a.m. to **>5:00<** p.m., Monday through Friday, excluding Federal holidays in the District of Columbia.

During working hours, all applicants, attorneys, and other members of the public should announce their presence to the Office personnel in the area of their visit. In the Technology Centers (TCs), visitors should inform the TC receptionist of their presence before visiting other areas of the TC.

>

### **I. < FILING OF PAPERS DURING UNSCHEDULED CLOSINGS OF THE U.S. PATENT AND TRADEMARK OFFICE**

37 CFR 1.9(h) provides that the definition of “Federal holiday within the District of Columbia” includes an official closing of the Office. When the entire **>USPTO<** is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a “Federal holiday within the District of Columbia” under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open. In addition, 37 CFR 1.6(a)(1) provides “[t]he Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia” to clarify that any day that is a Saturday, Sunday or Federal holiday within the District of Columbia is a day that the **>USPTO<** is not open for the filing of applications within the meaning of Article 4(C)(3) of the Paris Convention. Note further that in accordance with 37 CFR 1.6(a)(2), even when the Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia, correspondence deposited as Express Mail with the United States Postal Service in accordance with 37 CFR 1.10 will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or 37 CFR 1.7).

When the **>USPTO<** is open for business during any part of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the Office may be officially closed for some period of time during the business day because of an unscheduled event. The procedures of 37 CFR 1.10 may be used for filing applications.